

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated December 15, 2003, indicated that: the abstract and specification have been objected to for various informalities; claims 1-10 have been rejected under 35 U.S.C. § 112 for lack of antecedent basis; and claims 1-30 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Eberhardt et al.* (U.S. Patent No. 5,754,583) in view of *Levin et al.* (U.S. Patent No. 6,201,827).

With respect to the issues taken with the abstract and specification, Applicant has made the changes suggested in the Office Action as noted at paragraph 2, items “a” and “c”-“g”. With the above-presented amendments, Applicant has deleted the sentence referred to at item “b” of paragraph 2 and corrected the grammar issues noted at items “h” and “i” of paragraph 2. Consistent with the Office Action’s characterization of these issues and in accordance with the MPEP, Applicant notes that none of these issues present a concern of patentability; therefore, none of the above-presented amendments are intended to overcome any patentability issues. Rather, the above-presented amendments have been made for the purpose of improving the wording and readability of the text.

With respect to the rejection of claims 1 and 10 under 35 U.S.C. § 112, Applicant respectfully traverses. Regarding each of claims 1 and 10, Applicant submits that there exists proper antecedent basis for the terms cited. The term, “a combine operation” is supported and identifiable from the term at line 6 of claim 1, from which claim 10 depends. The term, “said second signal strength threshold” is supported and identifiable from the term, “second threshold” at line 9 of claim 1. As discussed at MPEP § 2173.05(e) (Lack of Antecedent Basis), the failure to provide explicit antecedent basis for terms does not render a claim indefinite if the scope of a claim would be reasonably ascertainable by those skilled in the art. Accordingly, the rejection of these claims should be removed. Notwithstanding, certain of the claims (including claims 1, 11

and 21) have been amended not for the purpose of overcoming any patentability issues but rather for the purpose of improving the wording and readability of the text.

Turning now to the rejection under 35 U.S.C. § 103, Applicant respectfully traverses. The subject matter set forth in each of the independent claims (as well as the dependent claims when taken alone or with the inherited language of the underlying independent claims) does not correspond to the asserted prior art, and the asserted prior art does not suggest that a skilled artisan would implement the combination as asserted in the Office Action. Because such correspondence and suggestion are requirements for establishing a *prima facie* rejection under § 103, Applicant submits that the rejection should be removed.

More particularly, the Office Action alleges that the skilled artisan would implement a combination of teachings from the '583 patent and the '827 patent. From the '583 patent, the Office Action has identified a discussion of background leading up to the alleged invention of the '583 patent (namely, column 2, lines 41-51, and column 3, lines 12-17). From the '827 patent, the Office Action relies on alleged teaching that would prevent a locked finger assignment from being deassigned if its signal strength would satiate a lesser-valued threshold. The '583 patent, however, teaches away from such a modification (as suggested by the '827 patent or otherwise).

The discussion cited in the '583 patent discusses a problem with conventional finger assignment locking and then points the skilled artisan to a suggested solution. The problem is that deep fades can cause an undesired finger assignment to unlock. The solution to this problem (according to the '583 patent) is to use signal averaging to produce a filtered signal and, using the filtered signal, to begin the combining process immediately once a finger assignment has been locked and, during a fade, to make unlocking much less likely. See the '583 patent, *e.g.*, at column 3, lines 1-17.

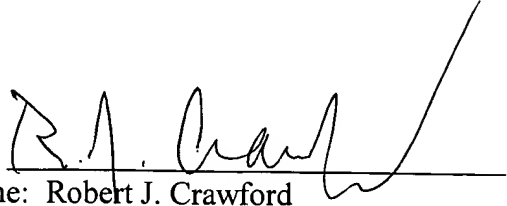
The Office Action argues in direct contrast to this signal-averaging teaching in the '583 patent. The Office Action argues that the skilled artisan would modify this cited discussion from the '583 patent by using a finger deassignment approach that (according to the '827 patent) would be based not on use of an averaged signal but rather on the determined maximum finger energy. As discussed in connection with the summary, claims and FIG. 5 of the '827 patent, the approach of the '827 patent is to determine

whether or not a signal is in lock by analyzing the maximum finger energy. Thus, the Office Action would propose to combine such an alleged finger deassignment approach (that bases its comparison on a determined maximum finger energy) with the signal-averaging approach of the '583 patent, but the maximum finger energy and the signal-averaged energy are not compatible for the embodiment of the '583 patent; therefore, this combination would undermine the purpose and operation of the '583 patent. According to MPEP § 2143.01, a § 103 rejection cannot be maintained when the asserted modification undermines the purpose or operation of the main reference. Because the combination asserted in the Office Action would undermine the purpose and operation of the '583 patent, Applicant submits that the rejection should be withdrawn.

Applicant further submits that the rejection should be withdrawn because the '827 patent does not teach that which is alleged in the Office Action and, when the actual teaching of the '827 patent is combined with the '583 patent, this combined prior art does not correspond to Applicant's claimed invention. As examples of this lack of correspondence and flawed interpretation, Applicant cannot ascertain how the '827 patent could be interpreted to teach any such deassignment, especially in view of the purpose being to determine if a signal is in lock. Further, the Office Action does not indicate where this reference teaches a second signal strength threshold being less than a first signal strength threshold. Moreover, in connection with the flow chart of FIG. 5 or the Office Action's citations, the '827 patent teaches that there is only one comparison threshold relevant to a finger signal level. In view of the Office Action's flawed interpretation, Applicant submits that the combination of actual teachings results in a hypothetical embodiment that fails to bear correspondence to Applicant's claimed invention at least with respect to each of the above misinterpreted areas.

Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Mr. Peter Zawilski, of Philips Corporation at (408) 474-9063.

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